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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/777,884	02/07/2001	James A. Johanson	129250-001020/US	3315
32498 7590 12/31/2009 CAPITOL PATENT & TRADEMARK LAW FIRM, PLLC P.O. BOX 1995 VIENNA, VA 22183			EXAMINER CHANKONG, DOHM	
			ART UNIT 2452	PAPER NUMBER
			MAIL DATE 12/31/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/777,884	Applicant(s) JOHANSON ET AL.	
	Examiner DOHM CHANKONG	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3-5, 19 and 30-37 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 3-5, 19, and 30-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

This non-final rejection is in response to Applicant's request for continued examination which was filed on 10/26/2009. Claims 3, 4, 19, 32, 36, and 37 are amended. Claims 1, 2, 6-18, and 20-29 were previously cancelled. Accordingly, claims 3-5, 19, and 30-37 are presented for further examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 10/26/2009 has been entered.

Response to Arguments

Applicant amends the independent claims to recite "selecting a device, from among nearby devices that are not grouped according to GPS co-ordinates." Applicant argues that (1) neither *Fumarolo* or *Bork* references disclose this new limitation and (2) the combination of *Fumarolo* and *Bork* is improper.

As to the second argument, Applicant seems to be contending that the Board of Patent Appeals and Interferences' decision was improper. The Board decided that "a communication unit based on GPS *combined with elements to communicate using the well known Bluetooth communication protocol* is nothing more than a 'predictable use of prior art elements according

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to their established functions.'" Thus, if Applicant believes that the Board's decision was in error, then the proper course of action is to appeal that decision. The examiner will follow the Board's decision (i.e., that the combination of *Fumarolo* and *Bork* is proper) until instructed otherwise.

As to Applicant's first argument, Applicant further argues that "*Fumarolo* appears to select a group of devices or an individual device have/has been grouped according to GPS coordinates." Applicant's argument is not persuasive for three reasons.

First, the limitation is a negative limitation (i.e., "selecting a device from among nearby devices *that are not* grouped according to GPS co-ordinates") that is not supported by Applicant's specification. Specifically, an "any negative limitation or exclusionary proviso must have basis in the original disclosure" and "the mere absence of a positive recitation is not basis for an exclusion." *MPEP* § 2173.05(i). Moreover, "any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement."

There is no explicit support in Applicant's specification for excluding devices that are grouped according to GPS coordinates from the selection feature. The specification only discloses selecting a device "based on the location of the electronic device" but is silent as to whether the devices can or cannot be selected from devices that are grouped according to GPS coordinates. Therefore, the claim fails to comply with the written description requirement and does not support the new amendment.

Second, Applicant's characterization that *Fumarolo* "appears to select a group of devices or an individual device that have/has been grouped according to GPS coordinates" is inaccurate.

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Fumarolo does not disclose selecting a device from devices that have been grouped according to GPS coordinates but selecting devices based on their location of a map [abstract | column 3 «lines 27-36»: “A display-based terminal displays a map to a user of the terminal, wherein the map indicates locations of communication units in at least a portion of the communication system. The terminal receives the user's selection of at least one communication unit from the map”]. Based on the user's selection, the device is then placed into a specific group [column 3 «lines 34-36»]. Thus, *Fumarolo* discloses selecting a device from devices that have not been grouped based on GPS location as claimed.

Third, the limitation is not given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). Thus, even if the limitation is supported by Applicant's specification, the limitation is in the claims' preamble and is not given patentable weight.

For the foregoing reasons, Applicant's arguments are not persuasive. The rejection as set forth in the previous office action are therefore maintained because *Fumarolo* discloses the new limitation as claimed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

I. CLAIMS 19 AND 32 ARE REJECTED UNDER 35 U.S.C. 112, FIRST PARAGRAPH, AS FAILING TO COMPLY WITH THE WRITTEN DESCRIPTION REQUIREMENT.

The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The limitation is a negative limitation (i.e., "selecting a device from among nearby devices *that are not* grouped according to GPS co-ordinates") that is not supported by Applicant's specification. Specifically, an "any negative limitation or exclusionary proviso must have basis in the original disclosure" and "the mere absence of a positive recitation is not basis for an exclusion." *MPEP* § 2173.05(i). Moreover, "any claim containing a negative limitation which does not have basis in the original disclosure should be rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement."

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Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

II. CLAIMS 3-5, 19, AND 30-37 ARE REJECTED UNDER 35 U.S.C. 103(A) AS BEING UNPATENTABLE OVER *FUMAROLO* ET AL. (U.S. PATENT NUMBER 6,204,844), HEREINAFTER REFERRED TO AS *FUMAROLO*, IN VIEW OF *BORK* ET AL. (U.S. PATENT NUMBER 6,246,376), HEREINAFTER REFERRED TO AS *BORK*.

Some claims will be discussed together. Those claims which are essentially the same except that they set forth the claimed invention as a device are rejected under the same rationale applied to the described claim.

Claims 19 and 32

Fumarolo as modified by *Bork* discloses a method for selecting a device, from among nearby devices that are not grouped according to GPS coordinates [*Fumarolo*, column 3 «lines 29-36»: selecting a device based on its location on a map *and then* grouping the devices based after the device has been selected] to communicate with, comprising the steps of:

transmitting a Bluetooth signal (*Bork*, column 4, lines 60-64 and column 5, lines 13-17);

detecting a plurality of Bluetooth signals from the nearby devices, each signal containing GPS coordinates of at least one nearby device (*Bork*, column 4, line 64 through column 5, line 2, for the use of Bluetooth, and *Fumarolo*, column 5, lines 35-41 and column 13, lines 32-42); and

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selecting one of the nearby devices associated with one of the detected signals to communicate with based on the received GPS coordinates (*Fumarolo*, column 5, line 61 through column 6, line 12 and column 13, lines 32-42).

As indicated in the foregoing mapping, *Fumarolo* did not explicitly state that his system's devices could communicate using Bluetooth signals. *Fumarolo*'s system does utilize a wireless infrastructure and it could easily be adapted to operate using any type of known wireless network. Furthermore, the ability to transfer GPS coordinates between devices using Bluetooth was well known in the art at the time of the applicant's invention as evidenced by *Bork*.

It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the system of *Fumarolo* by adding the ability to transmit and detect Bluetooth signals in such a communications system as provided by *Bork*. Here the combination satisfies the need for a GPS device that can communicate its location with another trusted device by using Bluetooth or a cellular link. See *Bork*, column 3, lines 29-34. This rationale also applies to those dependent claims utilizing the same combination.

Claims 30 and 33

Fumarolo as modified by *Bork* discloses the method as in claim 19 further comprising the step of: displaying the location of each nearby device associated with received GPS coordinates (*Fumarolo*, column 5, lines 35-41); and selecting the nearby device to communicate with based on the displayed locations (*Fumarolo*, column 13, lines 43-58).

Claims 31 and 34

Fumarolo as modified by *Bork* discloses the method as in claim 30 further comprising

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selecting a nearby device associated with a shortest location (*Fumarolo*, column 16, lines 8-26 and column 17, lines 25-42).

Claims 3 and 35

Fumarolo as modified by *Bork* discloses the method as in claim 30 further comprising displaying only those nearby devices within a certain range (*Fumarolo*, column 16, line 54 through column 17, line 6).

Claims 4 and 36

Fumarolo as modified by *Bork* discloses the method as in claim 19, wherein each of the detected signals includes the type of nearby device (*Fumarolo*, column 5, lines 41-60).

Claims 5 and 37

Fumarolo as modified by *Bork* discloses the method as in claim 4 further comprising the step of displaying the type of nearby device associated with each detected signal (*Fumarolo*, column 5, lines 41-60).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOHM CHANKONG whose telephone number is (571)272-3942. The examiner can normally be reached on Monday to Friday [10 am - 6 pm].

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thu Nguyen can be reached on (571)272-6967. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/DOHM CHANKONG/
Primary Examiner, Art Unit 2452